

Serial No. 10/801,273

Amendment in Resp. to Off. Action of March 15, 2006

UTILITY PATENT

B&amp;D No. JK01488A

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Applicants have canceled Claims 8-16 and 31-33. Currently in the above-identified application therefore are Claims 1-7 and 17-30.

The Examiner has rejected Claims 1, 4, 6-11, 13, 15-16, 24, 26 and 29-33 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,943,931 ("Stumpf") in view of US Patent No. 5,850,698 ("Hurn"). The Examiner also rejected Claims 2-3, 14, 17-18, 20-22 and 27-28 under 35 USC § 103(a) as being unpatentable over Stumpf in view of US Patent No. 3,611,859 ("Avakian"). In addition, the Examiner rejected Claims 5, 12, 19 and 25 under 35 USC § 103(a) as being unpatentable over Stumpf in view of US Patent No. 6,615,701 ("Hollinger"). The Examiner also rejected Claim 24 under 35 USC § 103(a) as being unpatentable over Stumpf in view of US Patent No. 3,447,577 ("Burrows"). These rejections are respectfully traversed.

Claim 1 calls for a miter saw, comprising a base having a support surface for at least partially supporting a workpiece, a workpiece positioning fence coupled to the base, said positioning fence being orientated substantially perpendicular to the support surface, and a cutting assembly pivotally mounted on the miter saw to achieve a plurality of positions, said cutting assembly including a motor orientated substantially perpendicular to an arbor for rotating a circular saw blade, and a gear assembly configured and arranged to transfer the rotational energy of the motor to the arbor, wherein the gear assembly and motor are configured so as to not contact the workpiece position fence when the cutting assembly is disposed at the cutting assembly's closest position to the base when mitering at least a 45 ° (forty-five degree) from a plane substantially perpendicular to the workpiece positioning fence. Independent Claims 17 and

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24 have similar elements.

As admitted by the Examiner, Stumpf does not show all elements of Claim 1. In particular, Stumpf does not show "the use of a gear assembly and a motor orientated substantially perpendicular to the miter saw." Instead, Stumpf discloses a motor 20 drivingly connected to the saw blade 16. Typically, where the motor is substantially distant from the saw blade, a belt is used to transfer the rotational energy of the motor to the arbor.

The Examiner relies on the teachings of Hurn to provide the gear assembly and the orientation of the motor. However, the Examiner has not met the *prima facie* case of obviousness for combining such references for several reasons.

First, Hurn is not analogous prior art, as it discloses a worm-drive circular saw, rather than a miter saw. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (quoted by MPEP § 2141.01(a), at 2100-115 (Aug. 2001, 8<sup>th</sup> ed.)).

*Oetiker* provides a good example of what can be considered analogous prior art in the mechanical arts, which include the present invention. In *Oetiker*, the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The CAFC

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held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

In the present case, the particular problem with which the inventors were concerned was maximizing cutting capacity of the miter saw while maintaining the bevel angle range. Such problem is not the type of problem that a worm-drive circular saw would resolve. As stated in Hurn, the worm-drive circular saw is used in those applications where a longer housing is used to reach a workpiece. Hurn, col. 1, lns. 36-42. This is not a problem for miter saws since the user disposes the workpiece right on the miter saw. Thus a person of ordinary skill would not review the worm-drive circular saw field to find solutions to maximizing cutting capacity.

Furthermore, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of maximizing cutting capacity while maintaining bevel angle range would reasonably be expected or motivated to look for a solution in the worm-drive circular saw field. Just like the PTO was not allowed to bring in hooks from the garment fastening field into the hose clamp fastening field, the Examiner should not be allowed to bring in transmissions and motor arrangements generators from worm-drive circular saw field into the miter saw field, especially where the Examiner has not provided any evidence that a person of ordinary skill would look in the worm-drive circular saw field. Applicants hereby request that the Examiner provide any evidence that persons skilled in the art would indeed act in such manner so that Applicants can fully prepare their argument in the event of an appeal to the Board is necessary.

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Since Hurn cannot be combined with Stumpf, Claims 1, 17 and 24 and their respective dependent claims are patentable.

Furthermore, even if Hurn was considered analogous prior art, the Examiner has failed to prove the *prima facie* obviousness case. According to MPEP § 2143, the Examiner must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

In the present case, there is no suggestion or motivation to replace Stumpf's belt-drive transmission with Hurn's gear transmission and motor arrangement. Admittedly, Stumpf can be modified with the teachings of Hurn to obtain the present invention. However, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). In other words, the Examiner cannot just explain that Stumpf can be combined with Hurn to obtain a certain result. Instead, the Examiner must explain why Stumpf and Hurn suggest "the desirability of the combination."

Because the Examiner has not pointed out why a person of ordinary skill in the art would modify Stumpf to obtain the present invention, the Examiner has failed to show a suggestion or motivation to combine Stumpf with Hurn. Accordingly, the Examiner has not met his *prima facie* burden. Thus, the Examiner should withdraw this rejection.

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In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-7 and 17-30 are respectfully requested.

The Commissioner is authorized to charge payment of a one-month extension fee (\$120.00), as well as any other fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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